

REMARKS

For the sake of clarity, claims 9, 11, and 12 have been amended. In claim 9, the preamble now recites a system for providing at least one retailer an advertising program to at least one potential respondent. The terms “retailer” and “respondent,” which may refer to actual human persons or to corporate entities, provide antecedent basis for instances of these terms in the body of claim 9 and claims dependent thereon. The claim term “program administrator” has been amended to recite a “program administrator system,” thereby clarifying applicant’s usage as referring to an inanimate structure. Claim 9 further recites the program administrator system as being configured to be in communication with the at least one retailer and to receive an activation of a saver card. The message generator is configured to generate a message. These amendments clarify the definition of the foregoing claim terms as being structural limitations, albeit recited in functional terms. Claim 11 has been amended on a similar basis to call for the correlator to be configured to gather transaction data, while claim 12 now calls for the correlator to be further configured to update the recorded profile.

Also for the sake of clarity, claim 15 has been amended to correct an obvious typographical error in the claim dependency. As now amended, claim 15 depends from system claim 11, as was obviously intended, instead being dependent from method claim 1.

Support for the foregoing amendments is provided by the specification, e.g. at page 4, line 22 through page 5, line 16; page 7, lines 7-8, 17-18, and 20, page 8, lines 17-18, and at the Abstract. Consequently, no new matter has been added.

The present method and system provide a versatile mechanism for the delivery of advertising material specifically targeted to potential consumers of goods or services, e.g. by tailoring the advertisements to a demographic profile of particular consumers. Such a targeting enhances the cost effectiveness of the advertising and minimizes the negative reactions often associated with the promotion of goods or services in which a particular consumer has no interest. The association of the program with a saver card further enhances the effectiveness of the present method and system.

Claims 9-15 were rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has stated that claims 9-13 [*sic - claims 9-15 may have been intended*] are system (apparatus) claims, yet they are said to set forth apparent method steps, rather than structure or components configured with certain capabilities. It is further said that it is unclear what structure is being claimed that is capable of performing the claim language.

Claims 9, 11, and 12 have been rewritten as set forth above. It is respectfully submitted that any indefiniteness resulting from the recitation of apparent method steps has thereby been mooted. In particular, claim 9 now calls for: (i) a program administrator system that is configured to be in communication with the at least one retailer to receive a first targeted advertisement; (ii) a plurality of saver cards appointed to be distributed to respondents; and (iii) a message generator that is configured to generate a first message in accordance with the first targeted advertisement. Applicant respectfully maintains that the foregoing structural elements are in fact structurally defined, notwithstanding the functional language descriptive of the actions that these elements may perform during operation of the claimed system. It is further submitted that claims 11-13 also define the structure of several of the system elements in functional terms. Applicant respectfully observes that the courts have repeatedly affirmed the propriety of using functional language to recite a structural feature in a claim. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997), quoting *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.").

The Examiner has not set forth any separate basis for the rejection of claims 14-15. Applicant thus presumes the rejection of these claims is based solely on alleged defects inherited from base claim 9 and intervening claim 11.

In view of the amendment of claims 9, 11, 12, and 15 and the foregoing remarks, it is maintained that any lack of clarity in claims 9-15 has been obviated.

Accordingly, reconsideration of the rejection of claims 9-15 under 35 USC 112, second paragraph, as being indefinite is respectfully requested.

Claims 9-15 were also rejected under 35 USC 101 as being directed to non-statutory subject matter. The Examiner has indicated that these claims are system (apparatus) claims but has inferred that certain features of the claims, viz. program administrator, retailer, and a respondent, are human beings.

With respect to the claim term “program administrator,” applicant respectfully submits that a skilled person would understand the specification’s usage of the term as referring to equipment, and not a human person. For example, refers to “e-mail messages, generated at a program administrator 14.” at page 7, lines 7-8 (emphasis added). It is submitted that the use of the preposition “at” instead of an alternative such as “by” clearly evidences applicant’s usage. The phrase “at the program administrator” is repeated at lines 17-18 and 20. Further and more explicit confirmation is provided at page 8, lines 17-18, which teaches that the program administrator may be a server, such as an Internet server. Such language clearly contemplates that the administrator is not a human person.

Nevertheless, for the sake of clarity, claims 9 and 11 have been amended to replace the term “program administrator” with the term “program administrator system” in each instance. Applicant respectfully submits that any potential confusion as to whether the claimed program administrator is a human being is thereby obviated.

Claim 9 (and claims 10-15 dependent thereon) have also been amended to recite in the preamble a system for providing for at least one retailer an advertising program to at least one potential respondent. The presence in the preamble of the terms “retailer” and “respondent,” which may refer actual human persons, provides antecedent basis for the subsequent occurrences of those terms in the claim body. While the claimed system is configured to interact with such entities, which may be actual persons or corporate institutions, it is submitted that the amended claim language clearly indicates to a skilled artisan that the claimed system does not include actual persons as claimed elements. Rather, such entities are employed only as antecedents for the functional recitation of elements that are clearly inanimate structural features. Applicant thus maintains that any basis for rejecting claims 9-15 as being directed to non-statutory subject matter has thereby been mooted.

Accordingly, reconsideration of the rejection of claims 9-15 under 35 USC 101 as being directed to non-statutory subject matter is respectfully requested.

Claims 1-6 and 9-14 were rejected under 35 USC 102(e) as being anticipated by US Patent 7,158,943 to van der Riet.

Applicant respectfully observes that the ‘943 patent issued January 2, 2007, from US Patent Application Serial No. 10/233,677, which was filed on September 4, 2002, a date subsequent to February 6, 2002, the filing date of the instant application. The van der Riet

application was published as US 2003/0126146 on July 3, 2003. Clearly, neither the '943 patent nor the '146 patent publication is available as prior art under 35 USC 102(b) against the present application.

The van der Riet application claims benefit of US Provisional Patent Application Serial No. 60/316,268. Applicant maintains that the van der Riet '943 patent and the '146 published application are available as prior art under 35 USC 102(e) only to the extent the subject matter therein is disclosed and enabled by the provisional patent application.

In the present instance, the Examiner has applied the '943 patent under 35 USC 102(e) and cited certain passages therein as allegedly disclosing the subject matter of claims 1-6 and 9-14. Applicant has reviewed the on-line version of the provisional patent application Serial No. 60/316,268 available through Public Pair. However, applicant has been unable to locate any disclosure or suggestion in the provisional application of the "loyalty card" purportedly provided by van der Riet. The loyalty card was apparently added only by way of the later filing of the utility application.

Significantly, base method claim 1 calls for the provision of at least one saver card to each of the at least two potential respondents. Likewise, amended claim 9 calls for a plurality of saver cards, at least one of the plurality being appointed to be distributed to each of the at least two potential respondents. The Examiner has equated applicant's saver card to van der Riet's loyalty card. Absent disclosure of this feature in the '268 provisional

patent application, it is submitted that the present novelty rejection of claims 1 and 9, as amended, is untenable under 35 USC 102(e).

Applicant further maintains that amended claims 2-6 and 10-14, respectively dependent from base claims 1 and 9, are patentable over van der Riet for at least the same reasons.

In view of the amendment of claims 9, 11, and 12 and the foregoing remarks, it is respectfully submitted that the method of claims 1-6 and the system of claims 9-14 are novel over van der Riet.

Accordingly, reconsideration of the rejection of claims 1-6 and 9-14 under 35 USC 102(e) as being anticipated by van der Riet is respectfully requested.

Claims 7, 8, and 15 were rejected under 35 USC 103(a) as being unpatentable over van der Riet.

For the reasons set forth hereinabove in connection with the novelty rejection of claims 1-6 and 9-14 over van der Riet, it is submitted that at least the saver card feature of claims 1 and 9 is not disclosed or suggested by the provisional patent application of which the '943 van der Riet patent claims benefit. As set forth above, the '943 van der Riet patent and the counterpart '146 patent publication are available under 35 USC 102(e) only to the extent the pertinent subject matter is disclosed and enabled by the provisional application. In the present instance, applicant maintains the saver card feature inherited by claims 7, 8,

and 15 from their respective base claims is not disclosed or suggested by the van der Riet provisional application, precluding an obviousness rejection.

Accordingly, reconsideration of the rejection of claims 7, 8, and 15 under 35 USC 103(a) as being obvious over van der Riet is respectfully requested.

In view of the amendment to claims 9, 11, 12, and 15, and the foregoing remarks, it is respectfully submitted that the present application has been placed in allowable condition. Reconsideration of the rejection of claims 1-15 and allowance of the present application, are, therefore, earnestly solicited.

Respectfully submitted,

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